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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,374	11/26/2001	Patrick O'Brien	65678-0045/5676 DCCS	3564

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EXAMINER
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GRAHAM, CLEMENT B

ART UNIT	PAPER NUMBER
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3692

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06/20/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/995,374	<b>Applicant(s)</b> O'BRIEN ET AL.	
	<b>Examiner</b> Clement B. Graham	<b>Art Unit</b> 3692	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 28 March 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. Claims 1-19 remained pending

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-19, are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao 6, 347, 302 in view of Bond US Patent No: 6, 738, 736.

4. Claims 1-19, are rejected under 35 U.S.C. 102(e) as being anticipated by Joao 6, 347, 302.

As per claim 1, Joao, discloses a method for benchmarking data relating to an asset, comprising the steps of selecting a group of assets that are included in the pool of benchmarking information on a computer.(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

Joao fail to explicitly teach identifying on a computer an asset characteristic relating to an asset included in the pool of benchmarking information; and invoking a benchmark heuristic on a computer to generate a benchmark value relating to the identified asset characteristic; wherein at least two, organizations contribute to the pool of benchmarking information.

However Bond discloses In an IT enterprise, multiple functions may be organized and categorized to provide comprehensive service to the user. The IT enterprise has an IT framework for understanding the interrelationships of the various functionalities and for managing a complex IT organization. The IT framework may include various operations management functionalities such as (1) a customer service management system function, (2) a service integration system, (3) a service delivery function, (4) a

capability development function, (5) a change administration function, (6) a strategy, architecture, and planning function, (7) a management and administration function, (8) a human performance management function, and (9) a governance and strategic relationships function. Within the strategy, architecture, and planning function, capacity modeling and planning plays an important role. The invention is directed toward a method and estimator for providing a capacity modeling and planning function in an IT framework.(see column 3 lines 28-46 and column 6 lines 10-67 and column 7-8 lines 1-67).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Joao to include teach identifying on a computer an asset characteristic relating to an asset included in the pool of benchmarking information and invoking a benchmark heuristic on a computer to generate a benchmark value relating to the identified asset characteristic; wherein at least two, organizations contribute to the pool of benchmarking information taught by Bond in order to provide an estimate for building a capacity modeling and planning function in an information technology organization. This aspect of the present invention allows an IT consultant to give on site estimations to a client within minutes. The estimator produces a detailed break down of cost and time to complete a project by displaying the costs and time corresponding to each stage of a project along with each task. Another aspect of the present invention is a computer system for allocating time and computing cost for building a capacity modeling and planning function in an information technology organization.

As per claim 2, Joao, discloses a wherein the selected group of assets are selected on the basis of a shared asset characteristic. .(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 3, Joao, discloses further comprising comparing the benchmark value to a characteristic of a target asset. .(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 4, Joao, discloses wherein the pool of benchmarking information and the benchmark value are stored on a database. (see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 5, Joao, discloses wherein at least two non-related organizations contribute to the pool of benchmarking information.(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 6, Joao, discloses wherein the benchmark value is cost information relating to the asset. (see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 7, Joao, discloses wherein organizationally identifiable information is not accessible to a end-user.(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 8, Joao, discloses wherein an end-user in one organization cannot view organizationally identifiable information belonging to a different organization.

As per claim 9, Joao, discloses a system for benchmarking data relating to an asset, comprising:  
a plurality of assets including an asset characteristic and a data value for said asset characteristic and a plurality of organizations with relationships to said plurality of assets.(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

Joao fail to explicitly teach benchmarking information pool including said data value for said asset characteristic for said plurality of assets associated with said plurality of organizations; and a benchmark heuristic to generate a benchmark value for said asset characteristic from said benchmarking information pool.

However Bond discloses In an IT enterprise, multiple functions may be organized and categorized to provide comprehensive service to the user. The IT enterprise has an IT framework for understanding the interrelationships of the various functionalities and for managing a complex IT organization. The IT framework may include various operations management functionalities such as (1) a customer service management system function, (2) a service integration system, (3) a service delivery function, (4) a

capability development function, (5) a change administration function, (6) a strategy, architecture, and planning function, (7) a management and administration function, (8) a human performance management function, and (9) a governance and strategic relationships function. Within the strategy, architecture, and planning function, capacity modeling and planning plays an important role. The invention is directed toward a method and estimator for providing a capacity modeling and planning function in an IT framework.(see column 3 lines 28-46 and column 6 lines 10-67 and column 7-8 lines 1-67).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Joao to include benchmarking information pool including said data value for said asset characteristic for said plurality of assets associated with said plurality of organizations; and a benchmark heuristic to generate a benchmark value for said asset characteristic from said benchmarking information pool taught by Bond in order to provide an estimate for building a capacity modeling and planning function in an information technology organization. This aspect of the present invention allows an IT consultant to give on site estimations to a client within minutes. The estimator produces a detailed break down of cost and time to complete a project by displaying the costs and time corresponding to each stage of a project along with each task. Another aspect of the present invention is a computer system for allocating time and computing cost for building a capacity modeling and planning function in an information technology organization.

As per claim 10, Joao, discloses a system for benchmarking data relating to an asset as in claim 9, wherein said plurality of organizations include at least two unrelated organizations. .(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 11, Joao, discloses said benchmarking information pool including a plurality of organizationally identifiable data, wherein said plurality of organizationally identifiable data is hidden from said benchmarking information pool before the application of said benchmarking heuristic.

As per claim 12, Joao, discloses wherein said plurality of organizationally identifiable data is hidden from said plurality of organizations.(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 13, Joao, discloses wherein said benchmark value is a monetary amount.(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 14, Joao, discloses said plurality of assets including a first asset characteristic, a second asset characteristic and a larger plurality of assets.(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67) wherein said plurality of assets are a subset of said larger plurality of assets; wherein said first asset characteristic is included in said benchmarking information pool; and wherein said plurality of assets are selective identified from said larger plurality of assets on the basis of said second asset characteristic.(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 15, Joao, discloses wherein said second asset characteristic is not included in said benchmarking information pool.(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 16, Joao, discloses further comprising a target asset including said asset characteristic and a target value, wherein said system automatically compares said target value to said benchmark value. .(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 17, Joao, discloses further comprising a database, wherein said pool of benchmarking information is stored on a database. .(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 18, Joao, discloses further comprising a plurality of asset values and a plurality of benchmark values, wherein said benchmark heuristic generates said plurality of benchmark values from said plurality of asset values. .(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67).

As per claim 19, Joao, discloses a system for benchmarking data relating to an asset, comprising:

a plurality of assets, including a subset of selected assets, wherein each asset in said plurality of assets includes a plurality of asset characteristics and wherein each said asset characteristic has a data value.(see column 2 lines 9-67 and column 5 lines 37-67 and column 6-8 lines 1-67)

Joao, fail to explicitly teach a plurality of organizationally identifiable data, including a subset of said asset characteristics and said data value relating to said asset characteristics, a plurality of unrelated organizations with relationships to said plurality of assets, a benchmarking information pool including said data value for said asset characteristic for said plurality of assets associated with said plurality of organizations, and a benchmark heuristic to generate a plurality of benchmark values for said plurality of asset characteristics from said benchmarking information pool.

However Bond discloses In an IT enterprise, multiple functions may be organized and categorized to provide comprehensive service to the user. The IT enterprise has an IT framework for understanding the interrelationships of the various functionalities and for managing a complex IT organization. The IT framework may include various operations management functionalities such as (1) a customer service management system function, (2) a service integration system, (3) a service delivery function, (4) a capability development function, (5) a change administration function, (6) a strategy, architecture, and planning function, (7) a management and administration function, (8) a human performance management function, and (9) a governance and strategic relationships function. Within the strategy, architecture, and planning function, capacity modeling and planning plays an important role. The invention is directed toward a method and estimator for providing a capacity modeling and planning function in an IT framework.(see column 3 lines 28-46 and column 6 lines 10-67 and column 7-8 lines 1-67).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Joao to include a plurality of organizationally identifiable data, including a subset of said asset characteristics and said data value relating to said asset characteristics, a plurality of unrelated



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organizations with relationships to said plurality of assets, a benchmarking information pool including said data value for said asset characteristic for said plurality of assets associated with said plurality of organizations, and a benchmark heuristic to generate a plurality of benchmark values for said plurality of asset characteristics from said benchmarking information pool taught Bond in order to provide an estimate for building a capacity modeling and planning function in an information technology organization. This aspect of the present invention allows an IT consultant to give on site estimations to a client within minutes. The estimator produces a detailed break down of cost and time to complete a project by displaying the costs and time corresponding to each stage of a project along with each task. Another aspect of the present invention is a computer system for allocating time and computing cost for building a capacity modeling and planning function in an information technology organization.

### **Conclusion**

### **RESPONSE TO ARGUMENTS**

5. Applicant's arguments filed 3/28/07 has been fully considered but they are moot in view of new grounds of rejections.


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B Graham whose telephone number is 703-305-1874. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 703-308-0505. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-0040 for regular communications and 703-305-0040 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CG

June 6, 2007

  
FRANTZY POINVIL  
PRIMARY EXAMINER  
Au 3692